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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,522	06/04/2001	Hideyuki Sakamoto	NEC01P072-TSe	3317

30743 7590 12/05/2005

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EXAMINER

DUNHAM, JASON B

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3<sup>rd</sup>, 2005 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4 & 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie (U.S. Patent No. 5,970,469).**

Referring to claim 1. Scroggie discloses a method of trial purchase for allowing users of a plurality of terminals connected to commodity providing means through a network to experience a purchase procedure of a commodity provided from said commodity providing means through said network, said method comprising the steps of:

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- Displaying information for a user about a commodity provided from said commodity providing means for trial purchase on one of said terminals (column 7, line 53 – column 8, line 2);
- Determining by a computer whether or not the user is eligible for a trial purchase procedure, said determination being made from a database recording prior uses of said commodity providing means, including prior uses of said trial purchase procedure (Scroggie: column 4, lines 33-50); The examiner notes that Scroggie discloses a method of a customer ID being used to identify prior users eligible for incentives.
- If the user is determined to be eligible, performing by a computer for the user using said terminal said trial purchase procedure and recording in said database said performance as a prior user by said user (Scroggie: column 4, lines 33-50); and
- If the user is determined not to be eligible notifying by a computer the user at said terminal that said trial purchase procedure cannot be provided (Scroggie: column 4, lines 33-50).

Referring to claim 2-4. Scroggie further discloses a method comprising the steps of:

- Storing a delivery destination in a previous purchase of the user (Scroggie: abstract) and;

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- Providing delivery of said commodity for trial purchase to said previously stored destination when said commodity is specified on said terminal (Scroggie: abstract).
- Designating said previously stored destination or a newly designated destination as a destination of said commodity (Scroggie: abstract).
- Storing said newly designated destination (Scroggie: abstract).

Referring to claim 34. Scroggie further discloses a method of gathering customer information on users of a plurality of terminals from said terminals connected to a network, said method comprising the steps of:

- Providing said terminal with information on a commodity for trial purchase to allow experience of a procedure of commodity purchase through said network (Scroggie: abstract);
- Causing entry of customer information on a user who makes an order for said commodity based on said commodity information into said terminal when said order is received (Scroggie: abstract);
- Determining by a computer whether or not said user is eligible for trial purchase of said commodity, said determination being made from a database recording prior use by said user of said procedure of commodity purchase through said network, including prior purchases of a commodity for trial purchase (Scroggie: column 4, lines 33-50);
- If the user is determined to be eligible, placing said received order (Scroggie: figure 5); and

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- If the user is determined not to be eligible, notifying the user at said terminal that said received order cannot be placed (Scroggie: column 4, lines 33-50). The examiner notes that Scroggie discloses a method wherein certain discounts or order cannot be placed unless customer information is entered and checked against a database for eligibility.

Referring to claim 35. Scroggie further discloses a method of gathering customer information wherein said customer information is previously stored and said previously stored customer information is updated when said commodity for trial purchase is ordered on said terminal (Scroggie: column 9, lines 29-40 & figure 9).

Referring to claim 36. Scroggie further discloses a method of gathering customer information comprising the steps of storing the name of said commodity for trial purchase in correspondence with the customer information of said user who ordered said commodity (Scroggie: column 6, lines 1-18).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 5-33 & 37-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scroggie (U.S. Patent No. 5,970,469) in view of Garg (U.S. Patent No. 6,571,216).**

Referring to claims 5-8. Scroggie teaches all of the above as noted under the 102(b) rejection, but does not expressly disclose a method of providing a commodity for trial purchase free of charge. Garg discloses a method wherein said commodity is free of charge (Garg: column 3, lines 10-40). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Scroggie to provide a commodity for free, as taught by Garg, to provide a system for giving rewards that supports targeting and profiling of users (Garg: column 3, lines 1-4).

Referring to claim 60. The combination of Scroggie and Garg further teaches a method comprising the steps of:

- Displaying a price of a free commodity (Garg: column 8, lines 27-64 & column 9, line 66 – column 10, line 6);
- Displaying a page for selecting a payment method (Scroggie: abstract). The examiner notes that Scroggie discloses a method of entering a credit or check card ID number.

Referring to claims 9-22. Claims 9-22 are rejected under the same rationale set forth above.

Referring to claims 23-32. The combination of Scroggie and Garg further teaches a trial purchase system (Scroggie: abstract) comprising backup means for

holding the commodity information stored in said commodity information storing means (Scroggie: figure 15).

Referring to claims 33 & 61. Claims 33 & 61 are rejected under the same rationale set forth above.

Referring to claims 37-39. Claims 37-39 are rejected under the same rationale set forth above.

Referring to claims 40-55. Claims 40-55 are rejected under the same rationale set forth above.

Referring to claims 56-59. Claims 56-59 are rejected under the same rationale set forth above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Horstmann (U.S. Patent No. 6,363,356) discloses a system and method for trial purchases of software.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

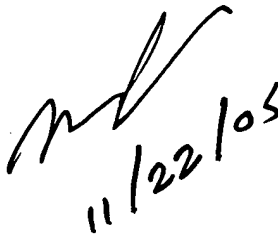
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JBD  
Patent Examiner  
11/22/05

A handwritten signature, possibly reading 'M. J. D.', is written above the date '11/22/05'.